The Air Jordan Rules: Image Advertising Adds New Dimension to Right of Publicity–First Amendment Tension

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Cover Page Footnote
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Stephen McKelvey,* Jonathan Goins,† & Frederick Krauss‡

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INTRODUCTION

Every year, corporations spend on average nearly thirty-five billion dollars on sports-related marketing, ranging from stadium naming rights and promotional sponsorships, to commercials and endorsement deals. In mining through some of the potential legal traps, corporate advertisers understand that utilizing the name, image, or likeness of athletes or celebrities in marketing and promotional campaigns requires some form of consent and compensation. Corporations hire lawyers for “advertising clearance” to ensure that slogans, logos, and images are available for use, and that video and music in audio-visual recordings are otherwise licensed. The concept of getting permission or authorization is relatively straightforward. However, gray areas remain.

For example, what if an assemblage of athletes’ names, images, and biographical information are incorporated in a social media campaign—developed and promoted by a single company—that merely aggregates public information? Or what if a company produces a print advertisement seeking solely to congratulate an athlete for a career achievement? These questions lie at the core of two recent cases in which courts have been challenged to determine where brand, or “image advertising,” resides at the nexus of the First Amendment, commercial speech, and the laws governing

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the right of publicity. More specifically, the courts in these cases analyzed whether the use of athletes’ likeness within these particular advertising contexts amounted to noncommercial speech (thus deserving of a higher degree of First Amendment free speech protection), or conversely, commercial speech (thus deserving of a lesser degree of First Amendment protection).

The plaintiffs in these cases are two of the most legendary athletes of our time. In *Spitz v. Samsung Electronics America, Inc.*, iconic Olympic swimmer Mark Spitz and numerous other notable Olympians sued Samsung over a Samsung-sponsored Facebook app that incorporated names, images, and biographical information of over 10,000 current and former Olympic athletes. While acknowledging that Samsung’s sponsorship of the Olympic Genome Project Facebook app was intended to enhance its brand image, the court, in ruling for the defendants, classified Samsung’s activity as noncommercial speech. In its ruling, the court relied heavily on the second case this Article addresses: *Jordan v. Jewel Food Stores (Jordan I)*.

In *Jordan I*, Chicago-based drugstore chain Jewel-Osco ran a print advertisement in a national sports publication, congratulating Bulls’ legend Michael Jordan on his enshrinement in the Basketball Hall of Fame. The advertisement mentioned Jordan’s name and featured an image of a pair of sneakers with the number “23,” and identified the drugstore by its own name, stylized logo, and slogan.

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3 Although these two cases involve athletes, the issues apply as equally to non-sport celebrities. For this reason, the terms “athletes” and “celebrities” are used interchangeably throughout this Article.

4 *Spitz*, 2013 WL 6816181, at *1. Team Epic, the promotion agency that developed and managed Samsung’s Genome Project, was also named in the lawsuit and took the lead in defending it.


7 The disposition of this case was based on an anti-SLAPP motion. See infra Part III.

8 *Jordan I*, 851 F. Supp. 2d 1102 (N.D. Ill. 2012), rev’d, 743 F.3d 509 (7th Cir. 2014).

9 *Id.* at 1104.
Despite its obvious reference to Jordan’s identity, the district court deemed the speech a congratulatory message, and noncommercial in nature.

The Spitz and Jordan I decisions confirmed that at least in some contexts—here, the aggregation of public information and congratulatory messaging—companies could legally incorporate athlete names and other indicia of identity in advertising campaigns that, while promoting the corporation itself, were not designed to sell a specific product or service. Such advertising, despite its inclusion of athletes’ indicia, was deemed noncommercial and hence entitled to the full protection of the First Amendment.

This proposition, however, took a precedent-setting U-turn in February 2014, when the Seventh Circuit for the U.S. Court of Appeals reversed the district court’s decision in Jordan I. In Jordan II, the Seventh Circuit held that although Jewel-Osco’s congratulatory advertisement did not promote or sell a specific product or service, its purpose as “image advertising” was enough to classify the advertisement as commercial speech, and thus eliminate Jewel-Osco’s First Amendment noncommercial speech defense. As a result, Jordan was given the green light to resume pursuing his right of publicity claim under Illinois statutory law, in which he sought five million dollars in damages. Although the parties ultimately settled in November 2015 and the facts of Spitz and Jordan II...

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10 Id. at 1105.
11 Id.
13 Jordan II, 743 F.3d at 512.
14 765 ILL. COMP. STAT. 1075/1 to 60 (2015).
15 Rovell, supra note 12.
16 See Jon Seidel, Michael Jordan Settles with Jewel, Dominick’s, CHI. SUN TIMES (Nov. 22, 2015, 5:26 PM), http://chicago.suntimes.com/news/7/71/1122975/grocery-chain-says-michael-jordan-settling-jewel-dominics [https://perma.cc/FE4Z-KUL9]. In addition to suing Jewel Food, Jordan also sued Dominick’s Finer Foods in response to its congratulatory advertisement in the same Sports Illustrated commemorating issue. Jordan v. Dominick’s Finer Foods, 115 F. Supp. 3d 950 (N.D. Ill. 2015). The Dominick’s ad stated, “Congratulations Michael Jordan: You Are a Cut Above.” Id. at 954. The bottom quarter of the ad, however, included a picture of a Rancher’s Reserve steak and a two dollar coupon toward the purchase of a steak at any Dominick’s location. Id. As with his
are distinguishable, these two cases have added a new and arguably conflicting dimension to the ongoing tension between the First Amendment freedoms of speech and expression and the right of publicity.

Part I of this Article begins by discussing the historical evolution of right of publicity law, from baseball cards to video games, followed by an examination of issues at the nexus of the right of publicity, trademark law, and the First Amendment. In Part II, we discuss the origins and evolution of the commercial speech doctrine, and the ongoing challenge in distinguishing non-commercial from commercial speech. In Part III, we examine the Spitz case in detail, including the rationale and reliance on the district court opinion in Jordan I. In Part IV, we discuss the Seventh Circuit’s opinion in Jordan II, which rebukes the rationale in Spitz through its expansion of the U.S. Supreme Court’s Bolger test. Specifically, the Seventh Circuit held that the failure to reference a specific product in the commercial-speech analysis “is far from dispositive, especially where ‘image’ or brand advertising rather than product advertising is concerned.” In Part V we discuss the legal and practical implications of Spitz and Jordan II, especially if the Seventh Circuit’s analysis of what constitutes commercial speech should be adopted by other jurisdictions. Ultimately, we conclude that the Seventh Circuit, while arguably broadening the scope of publicity rights through its re-interpretation of the Bolger test, non-
etnless shines a brighter light and sheds important guidance for companies seeking to use celebrity names and likeness in image advertising campaigns generally, and congratulatory ads in particular.

I. THE RIGHT OF PUBLICITY

A. The Right of Publicity as a Right of Privacy

The jurisprudence regarding the right of publicity grew initially out of the right of privacy over a century ago. The right of privacy’s fundamental principle was, in essence, the right “to be let alone.”19 In their famous law review article in 1890, Supreme Court Justice Louis Brandeis and scholar Charles Warren proposed that “the law must afford some remedy for the unauthorized circulation of portraits of private persons.”20 According to Supreme Court analysis of their text, “[T]he central thesis of the root article by Warren and Brandeis . . . was that the press was overstepping its prerogatives by publishing essentially private information and that there should be a remedy for the alleged abuses.”21 Lamenting the press for invading the private sphere, “Warren and Brandeis advocated right of privacy to forbid the publication of idle gossip and restore ‘propriety and dignity’ to the press.”22 The law, they asserted, protected the right of privacy to include the right of one’s “inviolable personality”23 as against the world:

We must therefore conclude that the rights, so protected, whatever their exact nature, are not rights arising from contract or from special trust, but are rights as against the world; and, as above stated, the principle which has been applied to protect these rights is in reality not the principle of private property, unless that word be used in an extended and

22 ROBERT P. MERGES, PETER S. MENELL & MARK A. LEMLEY, INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 1020 (5th ed. 2010) (internal citation omitted).
23 Warren & Brandeis, supra note 20, at 205.
unusual sense. The principle which protects personal writings and any other productions of the intellect or of the emotions, is the right to privacy, and the law has no new principle to formulate when it extends this protection to the personal appearance, sayings, acts, and to personal relations, domestic or otherwise.24

In 1960, noted scholar William L. Prosser expanded on the right “to be let alone” privacy principle by identifying four privacy torts,25 and his conceptualization was incorporated nearly verbatim into the Second Restatement.26 Prosser’s fourth privacy tort—appropriation of another’s name or likeness—is the principle behind what is now known as a right of publicity.27

B. The Right of Publicity as a Right to Control

Leaving the historical application of the “privacy” theory of the right of publicity, courts and scholars began developing a more expansive definition. As Professor Melville B. Nimmer predicted, what the celebrity really wants is not necessarily protection against an unreasonable intrusion of privacy, but a fundamental right to control his or her commercial value.28 “[A]lthough the well known personality does not wish to hide his light under a bushel of privacy, neither does he wish to have his name, photograph and likeness reproduced and publicized without his consent or without remuneration to him.”29 Now, courts in most jurisdictions uniformly hold

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24 Id. at 213.
25 William L. Prosser, Privacy, 48 CALIF. L. REV. 383, 389 (1960). These included: (1) unreasonable intrusion upon another’s seclusion; (2) public disclosure of private facts; (3) false light invasion of privacy; and (4) appropriation of another’s name or likeness. Id.
27 See id.; Prosser, supra note 25, at 389.
29 See id.; see also Paulsen v. Personality Posters, Inc., 299 N.Y.S.2d 501, 508 (Sup. Ct. 1968) (“What such a [public] figure really seeks is a type of relief which will enable him to garner financial benefits from the pecuniary value which attaches to his name and picture.”).
that the right of publicity should be considered as a free standing right independent from the right of privacy.30

Essentially, the right of publicity is a private cause of action under common or state law regarding the right of an individual to control the commercial use of his or her identity.31 There is no federal law applying the right of publicity.32 The principle is rooted in the cognizable property interest of a person’s right against unauthorized commercial uses of his or her name or likeness.33 The very core of the majority rule’s application of the right of publicity is best articulated by trademark law’s most renowned expert, J. Thomas McCarthy:

The right of publicity is the inherent right of every human being to control the commercial use of his or her identity. This legal right is infringed by unpermitted use which will likely damage the commercial value of this inherent right of human identity and which is not immunized by principles of free speech and free press. Infringement of the right of publicity is a commercial tort, and a form of unfair competition. The right of publicity is property, and is properly categorized as a form of intellectual property.34

McCarthy’s more expansive definition goes beyond just the right “to be let alone” (i.e., the right of privacy). He makes the right of publicity an “inherent right,” which is likely more expansive than Brandeis, Warren, or even Prosser would have ever intended.

Thus, the right of publicity has evolved first from being “let alone,” to the right to control, and finally, to not being commercially exploited. “Fundamentally, the right of publicity is the inherent right of every human being to control the commercial use of his or

31 RESTATEMENT (THIRD) OF CONTRACTS § 46 (AM. LAW INST. 1995).
32 For one of numerous articles that have advocated for passage of a federal right of publicity statute, see Risa J. Weaver, Online Fantasy Sports Litigation and the Need for a Federal Right of Publicity Statute, 9 DUKE L. & TECH. REV. 1 (2010).
34 5 MCCARTHY, supra note 28, § 28:1.
her identity”35 and to prevent against economic exploitation.36 As the entertainment and sports industries have grown, so too has case law on the rights of publicity. This right of publicity has developed in response to the “rise of mass advertising and the growing recognition that a celebrity’s imprimatur on a product or even association of a product with a celebrity’s persona enhances its appeal to consumers.”37 Proving a right of publicity claim varies from state to state, but in general a plaintiff must demonstrate that: (1) one’s name, likeness or image, (2) was misappropriated without permission, and (3) which likely caused harm to the commercial value of that person.38

C. State Right of Publicity Statutes

A right of publicity claim is a state-driven cause of action.39 A plaintiff who sues based on a right of publicity claim is cognizable by state statutory law or common law. Judge Jerome Frank, in a 1953 case in the Second Circuit, coined the term “right of publicity,”40 which prompted states to begin, as early as the 1970s, to enact statutes recognizing the right of publicity.41 As of April 2016, thirty-two states now recognize a right of publicity42: twenty-one of which recognize it under common law, and eleven of which have codified it by state statute.43 Some states, like California, recognize both a statutory and common law right of publicity.44

35 Miller v. Glenn Miller Prods., Inc., 454 F.3d 975, 988 n.6 (9th Cir. 2006) (quoting 5 MCCARTHY, supra note 28, § 28:1); see also 5 MCCARTHY, supra note 28, § 28:7 (noting that to trigger infringement of the right of publicity, the plaintiff must be “identifiable” from defendant’s unauthorized use).
36 Id. § 1:26 (describing the effect of Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866 (2d Cir. 1951) on the development of the right of publicity).
37 Id. § 1:26 n.5 (listing states that enacted statutes “codifying to varying extents the rights of privacy and publicity”).
38 5 MCCARTHY, supra note 28, § 28:7.
40 Id. § 1:26 (describing the effect of Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866 (2d Cir. 1951) on the development of the right of publicity).
41 Id. § 1:26 n.5 (listing states that enacted statutes “codifying to varying extents the rights of privacy and publicity”).
42 Id. § 6:3.
43 See MERGES, MENELL & LEMLEY, supra note 22.
44 See Miller v. Glenn Miller Prods., Inc., 454 F.3d 975, 988-89 (9th Cir. 2006) (”California law recognizes both a statutory and common law right of publicity.”).
Uniformly, the right of publicity under these state laws is rooted in the cognizable property interest of a person’s right against unauthorized commercial uses of his or her name, image, or likeness. Some state statutes also recognize a right of publicity even to a private citizen. For example, in Georgia, the right of publicity encompasses the “rights of private citizens, as well as entertainers, not to have their names and photographs used for the financial gain of the user without their consent, where such use is not authorized as an exercise of freedom of the press.” Although the states offer similar levels of protections to living persons, right of publicity protections for deceased celebrities vary.

D. Evolution of Right of Publicity Case Law

Jurisprudence on right of publicity has evolved down two paths: right of publicity in context of commercial advertising and right of publicity in the context of expressive works. The earliest case acknowledging the “right of publicity” was *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.* in 1953. In *Haelan*, the plaintiff had

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46 Toffoloni v. LFP Publ’g Grp., LLC, 572 F.3d 1201, 1206 (11th Cir. 2009) (quoting Martin Luther King, Jr. Ctr. for Soc. Change, Inc. v. Am. Heritage Prods., Inc., 296 S.E.2d 697, 703 (Ga. 1982)).

47 For example, California’s right of publicity statute provides in part that:

Any person who uses a deceased personality’s name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods, or services, without prior consent from the [decedent’s successor or successors in interest], shall be liable for any damages sustained by the person or persons injured as a result thereof.

CAL. CIV. CODE § 3344.1(a) (2002). Other states such as New York, however, do not recognize a right of publicity post-mortem. See Experience Hendrix, LLC v. Elec. Hendrix, LLC, No. C07–0338 TSZ, 2008 WL 3243896, at *3–4 (W.D. Wash. Aug. 7, 2008) (holding that assignee of the estate of deceased rock musician Jimi Hendrix could own trademarks in his name and image for various goods and services even though there was no right of publicity because Hendrix died domiciled in New York, which did not recognize a post-mortem right of publicity) (citing N.Y. CIV. RIGHTS LAW § 51 (2015)).

48 The focus within this Article is on the right of publicity in context of commercial advertising.

49 Haelan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866 (2d Cir. 1951), cert. denied, 346 U.S. 816 (1953); 5 McCarthy, supra note 28, § 28:4 (“Judge Jerome Frank in 1953 was the first to coin the term ‘right of publicity.’”). While as early as 1891 the U.S. Supreme Court recognized a person’s right to the use of his or her own name, it was not
negotiated exclusive licenses from several Major League Baseball ("MLB") players authorizing the use of their images on baseball cards that were included with packs of gum. 50 Defendant Topps, a rival company, sold its own gum with photographs of these same players.51 Haelan argued that the defendant had infringed upon Haelan’s exclusive right to employ the players’ pictures, even though the defendant knew of Haelan’s exclusive right of contract.52 Although ruling that New York’s privacy law statute did not extend to such uses, the court ruled that “a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing the picture, and that such a grant may validly be made ‘in gross’” under New York common law.53 In resolving the dispute, the court created a new right, the right of publicity, to be used when celebrities, entertainers, and public figures claimed misappropriation or infringement of their privacy.54 The Haelan court recognized that while celebrities may not suffer a high level of emotional harm when their identities are misappropriated, celebrities nevertheless need some type of protection from such activities.55 Right of publicity law continued to evolve and broaden in scope through a string of cases involving athletes, including MLB player Art Shamsky,56 auto racer Lothar Motschenbacher,57 and basketball legend Kareem Abdul-Jabbar.58 However,
recent high profile cases involving the emergence of fantasy gaming evinced a balancing of the right of publicity with the First Amendment and the fair use exception.59

E. EA Sports Cases Broaden Scope of Right of Publicity

Three recent cases involving former college athletes—Rutgers football player Ryan Hart60 and Arizona State quarterback Sam Keller61 against Electronic Arts (“EA”), and former UCLA basketball player Ed O’Bannon against the National Collegiate Athletic Association (“NCAA”)62—have arguably served to further expand the right of publicity beyond its originally intended scope.63 In 2009, Hart sued EA64 in federal court in New Jersey, asserting that

arguably attempted to ‘appropriate the cachet of one product for another.'” Id. at 413 (quoting New Kids on the Block v. News Am. Pub., Inc., 971 F.2d 302, 308 (9th Cir. 1992)). Additionally, the “right of publicity protects celebrities from appropriations of their identity not strictly definable as ‘name or picture.’” Id. at 415 (quoting Motschenbacher, 498 F.2d at 827).


63 Legal scholars have been highly critical of the courts’ arguable expansion of publicity rights at the expense of First Amendment freedoms. See, e.g., Mark Conrad, A New First Amendment Goal Line Defense—Stopping the Right of Publicity Offense, 40 OHIO N.U. L. REV. 743 (2014); Martin H. Redish and Kelsey B. Shust, The Right of Publicity and the First Amendment in the Modern Age of Commercial Speech, 56 WM. & MARY L. REV. 1443, 1444 (2015) (arguing that “the courts’ willingness to incorporate established precepts of commercial speech protection into their right of publicity calculus is long overdue”).

64 EA Sports, a division of EA, is the producer of the annual NCAA Football series of video games, which allow users to control avatars representing college football players as those avatars participate in simulated games. In EA Sports’ NCAA Football video game, the game features the ability to replicate each school’s entire team as accurately as
EA had used his image and likeness in its NCAA football video game (and in advertising promotions). On summary judgment, the court ruled in favor of EA, noting that Hart’s “identity” was limited to his likeness and biographical information. Further, the court found that the use of Hart’s likeness was sufficiently transformative to warrant First Amendment protection and that EA’s First Amendment interests outweighed Hart’s right of publicity in his likeness. Interesting to this case study, the court found that the video game itself did not constitute commercial speech due, in large part, to the nature of the use of the image at the time of its purchase. The court noted that Hart’s image was not used in any advertisement in promoting the video game and that his image was only accessible after the commercial transaction was already complete; a buyer had to proactively play the game and select use of the Hart avatar, and even then, the buyer had the ability to utilize the artistic and creative aspects developed by EA to manipulate the player avatars such as Hart.

EA’s victory was, however, short-lived. In May 2013, the Third Circuit reversed the lower court’s decision. After discussing the various tests previously established to determine right of publicity claims—the “transformative use” test, the “predominant use test,” and the “relatedness” or so-called Rogers Test—the court, possible. Every real football player on each team included in the game has a corresponding avatar in the game with the player’s actual jersey number and virtually identical height, weight, build, skin tone, hair color, and home state. See generally EA SPORTS, https://www.easports.com [https://perma.cc/DP9F-BNJU] (last visited Feb. 17, 2016).
65 Hart I, 808 F. Supp. 2d at 760.
66 Id. at 793–94.
67 Id.
68 Id. at 770.
69 Id.
70 Hart v. Elec. Arts, Inc. (Hart II), 717 F.3d 141 (3rd Cir. 2013).
71 See id. It is not within the scope of this Article to discuss in detail the elements and application of these various tests that jurisdictions have adopted to balance the right of
applying the transformative test, held that EA did indeed violate the plaintiff’s right of publicity.\(^72\) The Ninth Circuit held similarly in *Keller v. Electronic Arts, Inc.*,\(^73\) finding *Keller* to be “materially identical” to *Hart II*.\(^74\) The Keller court ruled that EA’s use of Keller’s image was not sufficiently transformative for two reasons. First, Keller and his videogame counterpart shared enough characteristics to be virtually identical.\(^75\) Second, EA had placed Keller’s videogame character in the precise setting that the real Sam Keller derived his fame: the football field.\(^76\) The court concluded that EA could not prove as a matter of law that its use of Keller’s likeness was permissible based on the transformative use defense.\(^77\) Thus, both the Third Circuit and Ninth Circuit agreed that EA’s use of the plaintiffs’ identities in NCAA football video games was not sufficiently transformative to receive First Amendment protection.\(^78\) Even more recently, in January 2015, the Ninth Circuit affirmed the district court’s decision in *Davis v. Electronic Arts, Inc.* to deny EA’s motion to strike the complaint brought by former professional football players.\(^79\) Although this recent spate of right of publicity

\(^{72}\) The Third Circuit reasoned that Hart’s real world likeness and player statistics used by the game were the foundation for its realistic gameplay, therefore, EA had not sufficiently transformed Hart’s likeness enough to be protected under the First Amendment. *See Hart II*, 717 F.3d at 168–70.

\(^{73}\) *Keller v. Elec. Arts, Inc.*, 724 F.3d 1268 (9th Cir. 2013).

\(^{74}\) *Id.* at 1278.

\(^{75}\) *Id.*

\(^{76}\) *Id.*

\(^{77}\) *Id.*

\(^{78}\) *Id.*

\(^{79}\) *Davis v. Elec. Arts, Inc.*, 775 F.3d 1172 (9th Cir. 2015). Similar to the complaints in the NCAA Football video game cases, the plaintiffs allege that EA created over 6,000 accurate unauthorized likenesses of former players who appeared on more than 100 historic teams in Madden NFL games. *Id.* at 1176. The plaintiffs asserted claims for right of publicity, conversion, trespass to chattels, and unjust enrichment. EA moved to strike the complaint as a strategic lawsuit against public participation (“SLAPP”) under California’s anti-SLAPP statute. *Id.* The district court denied EA’s motion on the
cases illustrates the arguable over-breadth of the right of publicity within expressive works, ultimately our focus here turns to the use of athlete persona in the context of commercial advertising.

F. The Nexus of Right of Publicity and the First Amendment

The way a company uses an athlete’s publicity in commerce, even without permission, can enable certain defenses, one of which is afforded by the First Amendment’s guarantee of freedom of speech and freedom of expression. Pursuant to the First Amendment, “Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the government for a redress of grievances.”

grounds that the plaintiffs established a reasonable probability they would prevail on their claims. Id. at 1177. Ultimately, the Ninth Circuit struck EA’s motion because they were unable to show that Madden NFL should be afforded First Amendment protection under any one of the five affirmative defenses they claimed. Id. at 1181.

See Daniel Gervais & Martin L. Holmes, Fame, Property, and Identity: The Scope and Purpose of the Right of Publicity, 25 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. (2014). Despite the expansion of the right of publicity doctrine, some courts have recently held the line in cases involving the use of game footage and photos. See Dryer v. Nat’l Football League, 55 F. Supp. 3d 1181 (D. Minn. 2014). In Dryer, a group of retired NFL players who chose to opt out of a previous class action settlement with the NFL filed a lawsuit claiming that the NFL’s use of video footage of players in television productions violated their publicity rights, caused consumer confusion, and unjustly enriched the league. Id. at 1186. In October 2014, the District Court of Minnesota granted summary judgment to the NFL, holding that the television productions recounting of professional football games were not commercial speech, and thus were fully protected by the First Amendment. Id. at 1193. Specifically, the court held that although the NFL had an economic interest in creating the productions, the league did not pay television networks to broadcast the productions, the productions used the players’ footage merely because the games could not be described visually any other way, and the productions did not reference a separate product or service. Id.; see also Marshall v. ESPN Inc., 111 F. Supp. 3d 815 (M.D. Tenn. 2015) (dismissing a lawsuit brought by several University of Tennessee football players against numerous media and broadcasting companies arguing that their rights of publicity have been infringed by broadcasters, and holding that the players in sporting events do not have publicity rights under common law in Tennessee, and moreover, that the plaintiffs failed to show that they had been deprived of any fundamental right).

U.S. CONST. amend. I.
The goal of the First Amendment is to secure the common good through the “free exchange of ideas.” As such, public discourse regarding topics like politics, religion, and other matters of opinion are considered noncommercial and, therefore, are afforded a certain level of constitutional protection. This level of scrutiny varies by the content of the speech. Content-based restrictions on speech are subject to a high bar of scrutiny and are only valid if the speech is necessary and tailored to serve a compelling state interest. Conversely, content-neutral restrictions are subject to an intermediate tier of scrutiny. Here, courts must balance governmental interests against the speaker’s right to free expression. The courts will rule “in favor of the government if its interests are important or substantial and do not burden the exercise of protected speech beyond what is necessary for their achievement.” Furthermore, the courts must uphold economic regulations, especially those that disclose noncontroversial information, if they are related to legitimate government interests within reason and are not “unjustified or unduly burdensome.” There are other types of speech that receive no constitutional protection. Clearly, the First Amendment will preempt publicity rights when persona is used in

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84 See Members of the City Council v. Taxpayers for Vincent, 466 U.S. 789, 804–05 (1984) (inquiring whether the government interest is sufficiently substantial to justify its content-neutral restriction).


the context of news reporting, commentary, entertainment, or works of fiction and nonfiction. The challenge comes when the use of persona falls within the “for purposes of trade” provision of the Third Restatement of Unfair Competition.

Typically, an unauthorized use of a person’s identity will fall within one of two categories: the challenged use is either “communicative” or “commercial.” A communicative use is one in which the policy of free speech predominates over the right of the person to his identity. Conversely, a “commercial” use of one’s publicity is much more likely to infringe upon the right of publicity. However, this distinction continues to provide a fertile ground for legal wrangling. Recent legal decisions and commentary document the ongoing tension between the right of publicity and the First Amendment. Within the sport context, relatively recent examples include two decisions involving online fantasy sports providers. In C.B.C. Distribution & Marketing, Inc. v. Major League Baseball Advanced Media L.P., the Eighth Circuit affirmed the district court ruling that MLB players have rights of publicity in their names and performance statistics; however, the court also held that those

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88 Mccarthy, supra note 28, § 28.6.
89 Restatement (Third) of Unfair Competition § 46 (Am. Law Inst. 1995). The Restatement clarifies “for purposes of trade” as a use in advertising the user’s goods or services, or on merchandise marketed by the user, or . . . in connection with services rendered by the user. Id. § 47.
90 See Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180 (9th Cir. 2001) (holding that a feature in a magazine using the name and photo of actor Dustin Hoffman was an entertainment story and not a misappropriation).
91 See Abdul-Jabbar v. Gen. Motors Corp., 85 F.3d 407 (9th Cir. 1996) (rejecting car manufacturer’s First Amendment defense that its use of Alcindor’s name was only “incidental” to conveying newsworthy sports information: “While Lew Alcindor’s basketball record may be said to be ‘newsworthy,’ its use is not automatically privileged. GMC used the information in the context of an automobile advertisement, not in a news or sports account.”).
92 See Eugene Volokh, Freedom of Speech and the Right of Publicity, 40 Hous. L. Rev. 904 (2004) (arguing that courts and legislatures have created a property-based right of publicity jurisprudence that goes beyond its original goals and encroaches on the traditional First Amendment guarantees afforded artistic and creative speech); see also ETW Corp. v. Jireh Publ’g, Inc., 332 F.3d 915 (6th Cir. 2003); Parks v. LaFace Records, 329 F.3d 437 (6th Cir. 2003); Winter v. DC Comics, 69 F.3d 473 (Cal. 2003); Doe v. TCI Cablevision, 110 S.W.3d 363 (Mo. Sup Ct. 2003).
93 C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P., 505 F.3d 818 (8th Cir. 2007).
names and performance statistics were within the public domain and hence CBC’s online fantasy game was protected under the First Amendment. 94 In a case involving football fantasy gaming, CBS Interactive v. National Football League Players Association 95 a Minnesota district court ruled in favor of CBS Interactive on essentially the same grounds as the Eighth Circuit in CBC. 96 In short, the courts have yet to develop a consistent approach in how to balance the right of publicity with First Amendment freedoms, a scenario made all the more challenging given the confusion that surrounds how we should define what constitutes commercial speech. 97

II. THE EVOLUTION OF THE “COMMERCIAL SPEECH” DOCTRINE

An examination of the commercial speech doctrine has historically encompassed two lines of inquiry. First, whether commercial speech is in fact subject to constitutional protection. The second line of inquiry—and continued source of confusion—is how commercial speech should be defined. In order to best understand the implications of the Spitz and Jordan cases, it is important to first understand the history and evolution of the commercial speech doctrine.

The notion of commercial speech emanates from the free speech provisions founded in the First Amendment. 98 The opera-
tive language of the First Amendment follows: “Congress shall make no law . . . abridging the freedom of speech.”\textsuperscript{99} Despite the fact that the text only directly refers to Congress, “the U.S. Supreme Court has held the Due Process Clause of the Fourteenth Amendment makes the freedom of speech provision applicable to state and local governments.”\textsuperscript{100} Accordingly, this extension of First Amendment protection allows for one to speak one’s mind without fear of persecution.\textsuperscript{101} Among those protections is the ability to express messages that involve religion, politics, and matters of public concern.\textsuperscript{102}

During the twentieth century, the notion began to emerge that speech, beyond that which was purely political, could also be afforded some lesser level of protection.\textsuperscript{103} The Supreme Court first enunciated the concept of commercial speech in \textit{Bigelow v. Virginia},\textsuperscript{104} holding that even speech that appears as paid commercial advertisements “is not stripped of First Amendment protection merely because it appears in that form.”\textsuperscript{105} The Court, however, stopped short of deciding “the precise extent to which the First Amendment permits regulation of advertising that is related to ac-

\begin{footnotesize}
  \begin{itemize}
  \item \textsuperscript{99} \textit{U.S. Const. amend. I}.
  \item \textsuperscript{100} Caitlin Brandon, \textit{Note, How a Grocery Store Grounded Air Jordan and Why Jordan Should Succeed in the Rematch: Redefining Commercial Speech for the Modern Era}, 47 \textit{Ind. L. Rev.} 543, 545 (2014) (citing \textit{Gitlow v. New York}, 268 U.S. 652, 666 (1925) (“[F]reedom of speech and of the press, which are protected by the First amendment from abridgement by Congress are among the fundamental personal rights and ‘liberties’ protected by the due process clause of the Fourteenth Amendment from impairment by the States.”)).
  \item \textsuperscript{102} \textit{Id.} at 160.
  \item \textsuperscript{103} One of the earliest Supreme Court decisions addressing commercial speech was \textit{Valentine v. Christensen}, 316 U.S. 52 (1942), which upheld a local ordinance prohibiting distribution in the streets of commercial and business advertising materials. Although the Court’s holding seemed to indicate that commercial speech was not entitled to constitutional protection, it would later use \textit{Bigelow v. Virginia}, 421 U.S. 809 (1975), to clarify that \textit{Valentine} should not be read as an absolute prohibition of constitutional protection for commercial speech.
  \item \textsuperscript{104} \textit{Bigelow}, 421 U.S. 809 (1975).
\end{itemize}
\end{footnotesize}
activities the State may legitimately regulate or even prohibit.”

The Court would shortly thereafter directly address whether commercial speech warranted any constitutional protection in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council*, in which the constitutionality of Virginia’s prohibition against advertising the prices of prescription drugs was analyzed.

Although the Supreme Court did not provide an explicit test to determine what is considered commercial speech, it did provide insight as to what is not considered commercial speech: “Commercial speech is neither speech that solicits money nor speech that is sold for a profit. Speech is also not necessarily commercial just because money was spent to project it.” Additionally, the Supreme Court concluded that there is a strong interest in the free flow of information for not only the individual consumer, but for society at large. As a result, the Court held that the fact that speech is commercial does not alone deprive it of constitutional protection.

Although *Virginia State Board of Pharmacy* expanded the commercial speech doctrine, the Supreme Court had yet to provide an explicit test for distinguishing commercial speech from noncommercial speech. The Court in *Central Hudson Gas & Electric Corp. v. Public Service Commission* finally established a test to determine

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106 *Id.* at 825.
107 425 U.S. 748 (1976). For the first time, the Supreme Court acknowledged that the issue of whether there is a First Amendment exception for commercial speech “is squarely before us.” *Id.* at 761.
108 *Id.*
109 *Id.* at 762.
110 *Id.* at 773.
111 *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557 (1980) (holding that the defendant state’s prohibition on the Public Service Commission’s right to advertise its services, despite its “commercial speech” nature, was unconstitutional). Subsequent to its decision in *Central Hudson*, the Supreme Court has offered further interpretations of the commercial speech doctrine in *Edenfield v. Fane*, 507 U.S. 761 (1993). In *Edenfield*, the Court held that it was not sufficient for the government merely to point to a considerable governmental interest and that the government must demonstrate that the regulation advanced the interest in a direct and material way. In *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484 (1996), the Court held that there was even less reason to start from the strict scrutiny review that the First Amendment generally required when a state entirely banned the dissemination of truthful, non-misleading commercial messages for reasons not associated with the protection of a fair bargaining process.
the difference between commercial and noncommercial speech. First, the Court defined commercial speech as an “expression related solely to the economic interests of the speaker and its audience.”112 Next, the Court created a four-part test to determine whether the commercial speech in question is protected by the First Amendment.113 The four-part test examines: (1) whether the expression is protected by the First Amendment, meaning that it concerns lawful activity that is not misleading; (2) whether the asserted governmental interest is substantial; if both of the first two parts are satisfactorily met then (3) whether the regulation directly advances the governmental interest asserted; and (4) whether it is more extensive than is necessary to serve that interest.114 The Court held that “[t]he State must assert a substantial interest to be achieved by restrictions on commercial speech. Moreover, the regulatory technique must be in proportion to that interest.”115

In 1983, the Supreme Court, in Bolger v. Youngs Drug Products Corp.,116 provided further guidance for distinguishing between commercial and noncommercial speech. In Bolger, a manufacturer and distributor of contraceptives brought an action challenging a federal statute prohibiting unsolicited mailing of contraceptive advertisements.117 The primary issue was whether the manufacturer’s pamphlets contained commercial speech, that is “speech which does ‘no more than propose a commercial transaction.’”118 The

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112 Cent. Hudson Gas, 447 U.S. at 561.
113 Id.
114 Id. at 561–66.
115 Id. at 564. In order to determine the scope of proper regulation of commercial speech, the Supreme Court created a four-step analysis:

We must (1) determine whether the expression is protected by the First Amendment. For commercial speech to come within that provision, it at least must concern lawful activity and not be misleading. Next, we ask (2) whether the asserted governmental interest is substantial. If both inquiries yield positive answers, we must determine (3) whether the regulation directly advances the governmental interest asserted, and (4) whether it is not more extensive than is necessary to serve that interest.

Id. at 566.
117 Id. at 67–68.
Court noted that the manufacturer’s informational pamphlets could not be characterized merely as proposals to engage in commercial transactions, and that their proper classification as commercial or non-commercial speech presented a closer question. 119 “The mere fact that these pamphlets are conceded to be advertisements clearly does not compel the conclusion that they are commercial speech.” 120 Similarly, the reference to a specific product does not by itself render the pamphlets commercial speech. 121 “And finally, the fact that the manufacturer has an economic motivation for mailing the pamphlets would clearly be insufficient by itself to turn the materials into commercial speech.” 122 Thus, the Court identified specific factors that have evolved, through subsequent interpretations and applications by lower courts, into the accepted test to determine if the speech in question is commercial: (1) whether the communication is an advertisement, (2) whether the communication makes reference to a specific product or service, and (3) whether the speaker has an economic motivation for the communication. 123 This three-part test became well-known as the Bolger test. 124

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119 Id.
120 Id. (citing N.Y. Times v. Sullivan, 376 U.S. 254, 265–66 (1964)).
121 Id. (citing Associated Students v. Att’y Gen., 368 F. Supp. 11, 24 (C.D. Cal. 1973)).
122 Id. at 67 (citing Bigelow v. Virginia, 421 U.S. 809, 818 (1975)).
123 Id.
124 According to a recent LexisNexis search, over 578 cases since 1983 have cited the Bolger test in a wide variety of factual contexts, including over thirty-three Supreme Court decisions and over 167 decisions from the U.S. Courts of Appeals. Despite the plethora of jurisprudence applying or adopting the Bolger test, there is a growing trend of commentators that have proposed different tests. See, e.g., Brandon, supra note 100, at 557. Brandon proposes an original three-part test to distinguish commercial speech from noncommercial speech. The elements of the test are as follows: “(1) identify the speaker and weigh the speaker’s motivations, (2) look at the content of the speech itself, and (3) assess how the average consumer or reader would view the speech.” Id. Specifically, Brandon says the first step is to determine the motive of the speaker. Id. Next, one must look to not only the content of the speech, but the mode within which it is being delivered. Id. at 557–59. Also, it is essential to take into account the “use of intellectual property rights of others by the speaker.” Id. at 558. Finally, the test would look towards how the average consumer would view the speech. Id. at 559–60. Brandon emphasizes that this factor should analyze the speech broadly, rather than with a narrow focus. Id. at 559. She argues that courts should look at several factors, including:

[Would the consumer gain some type of truth or objectively useful information from the speech . . . ; is there a trademark or trade name used which would trigger a commercial association in the mind of the
Courts have grappled most often with situations in which the challenged communication contains elements of both commercial and noncommercial speech. One of the most high profile cases to address this issue was *Kasky v. Nike, Inc.*125 Nike argued that advertisements placed in newspapers, the distribution of press releases, and the mailing of letters to athletic directors at major universities—all of which were designed to counter criticism of the working conditions of overseas factories manufacturing Nike products—did not amount to commercial speech, and hence were fully protected under the First Amendment free speech provisions of the U.S. and California constitutions.126 Noting that the U.S. Supreme Court “has not adopted an all-purpose test to distinguish commercial from noncommercial speech under the First Amendment,”127 the California Supreme Court likewise declined to do so.128 Instead, the California court created a limited-purpose test as to whether particular speech may be subjected to laws aimed at preventing false advertising or other forms of commercial deception; the test consisted of three elements: the speaker, the intended audience, and the content of the message.129

In holding for the plaintiff, the court concluded that in situations where there is a commercial speaker, an intended commercial audience, and commercial content in the message, the speech should be deemed to be commercial in nature.130 The court was

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126 A determination that Nike’s communications were not commercial speech would bar the claims of unfair competition and false advertising brought by plaintiff Kasky, a private California citizen. *Id.* at 262.
128 *Kasky*, 45 P.3d at 262.
129 *Id.*
130 *Id.* at 256–58. The court specifically held that Nike’s statements constituted commercial speech because: (1) Nike, being engaged in commerce, is a commercial speaker; (2) its statements were addressed directly to actual and potential purchasers of
also challenged with how to handle commercial speech that was intermingled with what would otherwise be constitutionally-protected noncommercial speech. Relying on Bolger, the court held that Nike could not immunize itself simply by including references to public issues, especially where the alleged false advertising and misleading statements all related to the commercial portions of the speech in question. The court further held that, because modern public relations campaigns are often designed to increase sales and profits by enhancing the image of the speaker, the press release amounted to commercial speech. The court thus concluded that speech is not necessarily entitled to the full protection under the First Amendment when it incorporates elements of both commercial and noncommercial speech. With the Supreme Court’s decision to withdraw its writ of certiorari in Kasky, an opportunity was missed to address a critical issue related to commercial speech: whether statements made by commercial enterprises which do not directly promote a product or service, but instead comment on social issues and general business practices, are commercial speech. Hence, the stage remained set for the latest legal skirmish over how to define commercial speech, as illustrated in the foregoing analysis of the Spitz and Jordan cases.

its products (a commercial audience); and (3) its representations of fact were of a commercial nature because it described its own labor policies and the practices and working conditions in factories where its products were made. Id. at 258.

Nike, relying on Board of Trustees of the State University of New York v. Fox, 492 U.S. 474 (1989), argued that because its commercial speech was “inextricably intertwined” with the noncommercial communications, its communications should be deemed noncommercial in its entirety. Citing Fox, the court stated that “[n]o law required Nike to combine factual representations about its own labor practices with expressions of opinion about economic globalization. . . .” Id. at 260. Although the U.S. Supreme Court initially granted a writ of certiorari to hear an appeal, it subsequently dismissed the writ as improvidently granted.

We see much the same rationale being applied by the Seventh Circuit in Jordan II in its application of the “modern” purpose of brand advertising. See infra Part V.

III. SPITZ AND ITS RELIANCE ON JORDAN I

The 2012 Summer Olympic Games in London were widely promoted as “the first social media Games.” For example, more than 220,000 fans “liked” a video highlight posted on Facebook of gymnast Gabby Douglas, and Olympians typically generated thousands of new followers immediately after winning gold medals. Further, athletes shared their Olympic experiences via various social media platforms such as Facebook, Twitter, and Instagram. In addition to the athletes themselves, corporate sponsors also embraced the power of social media. One of the most high profile examples was Samsung’s Olympic Genome Project, a Facebook app that enabled consumers to explore their personal connections with U.S. Olympians and to share this information with their friends in other online communities. The Genome Project was created on the notion that Americans “have long had a strong desire to get closer to the Olympians they cheer for, and that current social media has given rise to an opportunity to do so.” Samsung’s Genome Project, developed in cooperation with the United States Olympic Committee, went live in April 2012, and offered fans of the upcoming Summer Games “a unique interactive Facebook experience to the end-user.” Once the user accessed the app, a splash screen appeared and depicted the Samsung logo behind it. As the user further explored the app, it requested consent to access the user’s Facebook profile. The app then matched the information in the user’s Facebook profile to publicly available information of some 8,200 athletes included within the Genome Project database,


136 Id.

137 Id.

138 See infra note 141.


140 Notice of Motion to Strike, supra note 139, at 5.
resulting in an instantaneous display of those Olympians with whom the app user shared commonalities such as hometown, school, and favorite song.\textsuperscript{141}

The user could discover additional connections by participating in quizzes. The Genome Project then presented the user’s connections in a virtual “map,” whereby a “Connection Page” displayed the user at the center and his or her connections surrounding her.\textsuperscript{142} Since it was created via the user’s personal information, each “Connection Page” was thus unique to each user. Once the user learned that particular athletes were connected with her, she could discover more about the Olympians, view their “profiles,” and further explore commonalities.\textsuperscript{143} These profiles included such things as the athlete names, publicly available biographical information, and photographs.\textsuperscript{144}

The Genome Project also served as an online community wherein the user could share their connections and compete with other users.\textsuperscript{145} For instance, the app identified the user’s Facebook friends who were also shared connections with that particular athlete.\textsuperscript{146} Additionally, the user could accumulate points by interacting within the community to build their connections, and could also more intimately follow their favorite athletes by connecting to their Facebook News Feeds, personal websites, and Twitter accounts.\textsuperscript{147}

As inventive, interactive, and engaging as the Genome Project was, Samsung was quick to learn that using Olympic athletes in social media was not without its legal risks.\textsuperscript{148} Four months prior to the Opening Ceremonies of the London Games, twenty current and former Olympians\textsuperscript{149} sued Samsung and its promotion agency,

\begin{itemize}
  \item Id.
  \item Id.
  \item Id.
  \item Id.
  \item Id. The Connections page and profiles were the only parts of the application in which an athlete’s name, photograph or biographical information was displayed. \textit{Id.} at 6.
  \item Id.
  \item Id.
  \item Id.
  \item Id.
  \item Id.
  \item Opposition to Team Epic LLC’s Motion to Strike Plaintiffs’ First Amended Complaint, Spitz v. Samsung Elecs. Am., Inc., No. BC 483475, 2013 WL 6816181 (Cal. Super. Ct. Jan. 10, 2013) \textit{[hereinafter Opposition to Motion to Strike].} In addition to lead plaintiff Mark Spitz, the other plaintiffs consisted of a “who’s who” of Olympic
\end{itemize}
Team Epic, in a California superior court, alleging, inter alia, a violation of their right of publicity under common law and statutory misappropriation of their names and images. In response, the defendants immediately filed an anti-SLAPP motion: a motion, unique to the state of California, designed to limit litigation that would impinge the First Amendment. Specifically, the anti-SLAPP statute provides:

A cause of action against a person arising from any act of that person in furtherance of the person’s right of petition or free speech under the United States or the California Constitution in connection with a public issue shall be subject to a special motion to strike, unless the court determines that the plaintiff has established that there is a probability that the plaintiff will prevail on the claim.

The purpose of the anti-SLAPP statute is to “encourage participation in matters of public significance by allowing a court to promptly dismiss unmeritorious actions or claims brought to chill

champions including: Greg Louganis, Jackie Joyner-Kersee, Janet Evans, Dara Torres, Amanda Beard, Aaron Peirsol, Jason Lezak, Cullen Jones, Phil Dalhausser, Bradley Schumacher, Jessica Hardy, Brooke Bennett, Kristy Kowal, Christopher Burckle, Caroline Burckle, Eric Shanteau, Kim Vanderberg, Margaret Hoelzer, and Brittany Hayes. All were or are represented by the same agent, Evan Morgenstein. Id.

Section 3344(a) of the California Civil Code provides:

(a) Any person who knowingly uses another’s name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person’s prior consent, or, in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof.

CAL. CIV. CODE § 3344(a) (West 2012).

Notice of Motion to Strike, supra note 139, at 6 (citing Braun v. Chronicle Publ’g Co., 52 Cal. App. 4th 1036, 1042 (1997). See CAL. CIV. PROC. CODE § 425.16 (West 2015). California’s anti-SLAPP statute was enacted “to nip SLAPP litigation in the bud” by quickly disposing of claims that target the exercise of free speech rights. See Braun, 52 Cal. App. 4th at 1042.

CAL. CIV. PROC. CODE § 425.16(b)(1).
another’s valid exercise of the constitutional rights of freedom of speech.”

Although the *Spitz* decision was lightly-publicized—especially given the name renown of the plaintiffs coupled with the public appeal of the Olympics—it nonetheless held important ramifications for how athletes could be utilized within social media platforms. The Superior Court of the State of California for the County of Los Angeles ruled in favor of Samsung and Team Epic on its anti-SLAPP motion, based on its decision that Samsung’s Facebook app qualified as fully-protected noncommercial speech. As Judge Kwan held, the display of the plaintiff’s names, images, and biographical information “constituted written statements made in a public forum and in connection with issues of public importance.” Further, Judge Kwan held that the challenged speech contained in the Genome Project was non-commercial speech fully protected by the First Amendment, especially given that all the information was already readily available to the public. Judge Kwan held that the Olympic Genome Project did not propose a commercial transaction, nor did it contain advertisements for specific Samsung products. As she ruled:

> The fact that the logo “Created by Samsung” could be seen in the application does not convert the Olympic Genome Project into commercial speech. . . . The logo merely served to identify Samsung as the creator of the Olympic Genome Project. Further, no specific product was specifically refe-

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153 Id. § 425.16(a). An anti-SLAPP analysis involves a two-step process. First, the defendant must make a prima facie showing that the plaintiff’s suit is subject to the statute by showing his or her challenged acts were taken in furtherance of his or her constitutional rights of petition or free speech in connection with a public issue. Id. § 425.16(b)(1). If the defendant satisfies this first step, the burden shifts to the plaintiff to demonstrate there is a reasonable probability he or she will prevail on the merits at trial. Id.

154 See *Spitz*, 2013 WL 6816181, at *1.

155 Id.

156 Id. The question of whether speech is properly characterized as commercial or non-commercial is a question of law. The court cited the *Jordan I* case for the proposition that “[s]peech that does no more than propose a commercial transaction is what defines commercial speech.” Id.

157 Id.
renced or mentioned. Moreover, even if the display of the Samsung logo could somehow be viewed as introducing minimal elements of commercialism, those elements are intertwined with and overwhelmed by the message’s non-commercial aspects, thereby rendering the entirety of the Olympic Genome Project non-commercial . . . . Finally, the fact that Samsung may have acted with economic motivation . . . does not, in and of itself, turn the application and its content into commercial speech.158

Judge Kwan’s analysis chiefly focused on the fact that all of the information used by Samsung was already in the public domain. To support this, she relied heavily on both Gionfriddo v. Major League Baseball159 and CBC.160 Gionfriddo involved a group of rather unknown former MLB players (including outfielder Al Gionfriddo)161 who sued the MLB for alleged right of publicity violations based upon the league’s inclusion of the players’ names and playing statistics in its All-Star Game and World Series magazines and on its website. The district court in Gionfriddo held that use of the players’ names and statistics were (1) in connection with news, public affairs, or sports accounts, and (2) constituted publication of matters of public interest.162 The California Court of Appeals affirmed, concluding that the information conveyed was factual data and statistics about the players and that MLB was simply making historical facts available to the public.163

158 Id. at 3 (citing Jordan I, 851 F. Supp. 2d 1102 (N.D. Ill. 2012), rev’d, 743 F.3d 509 (7th Cir. 2014); Bernardo v. Planned Parenthood Fed’n of Am., 115 Cal. App. 4th 322 (2004)).
160 C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P., 505 F.3d 818 (8th Cir. 2007).
161 Gionfriddo, whose major league career totaled 226 games over four seasons primarily with the Brooklyn Dodgers, is best remembered for his spectacular catch of a drive off the bat of New York Yankees’ Joe DiMaggio in Game Six of the 1947 World Series.
162 See Gionfriddo, 94 Cal. App. 4th at 413–16.
163 See id. at 411. The court held that such usage was protected by section 3344 of the California Civil Code and the constitutional protection of freedom of expression; as such, it did not rise to the level of commercial speech.
In seeking to distinguish their case, the plaintiffs in *Spitz* argued that the players in *Gionfriddo* had not made claims that their names and statistics appeared in the context of advertising; nor had they shown that MLB’s usage damaged their marketability. Instead, they argued that Samsung’s use of their names and images were clearly in a commercial context. The plaintiffs pointed to the fact that Samsung’s name and logo were displayed on every page of the app, there were links to Samsung’s corporate website, and there were games and quizzes that promised discounts on Samsung’s products (although this feature was disabled before the official launch of the app). In arguing that the app amounted to commercial speech, the plaintiffs also alleged that the app’s main purpose was to enhance Samsung’s brand identity.

Judge Kwan also relied heavily on the Eighth Circuit decision in *CBC*, in which the plaintiff marketer of online fantasy baseball games sought declaratory judgment regarding its right to use MLB player names, statistics, and other biographical information. The Eighth Circuit upheld CBC’s right to use this information, ruling that “the information used in CBC’s fantasy baseball games is all readily available in the public domain, and it would be a strange law

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164 Opposition to Motion to Strike, supra note 149, at 11–12. Given the roster of nondescript players who joined Gionfriddo in this lawsuit, it is arguable that, to the extent that any of these plaintiffs had marketability, it was limited at best.

165 Id. at 12. Arguably, one key distinguishing factor overlooked by Judge Kwan is that Samsung was the sole advertiser in the Genome Project App, whereas the game program at issue in Gionfriddo included multiple advertisers.

166 Id. There were a number of features that were disabled before the launch of the app. Judge Kwan held that any features that may have been contemplated, but were not activated, were irrelevant for dispensation of the case.

167 Id. at 8.

The plain facts... establish the commercial purpose of the application. All of those pages contain Samsung’s name and logo... Incredibly, both Samsung and Team Epic admit that the purpose of the Application was to enhance Samsung’s brand identity. In paragraph 3 of Doug Hall’s declaration... he admits that a goal of the Application was to “increase Samsung’s profile among users of social media.”

that a person would not have a First Amendment right to use information that is available to everyone.” 169 The Eighth Circuit further found that “the facts in this case barely, if at all, implicate the interests that states typically intend to vindicate by providing rights of publicity to individuals.” 170 Despite the factual differences between Spitz, Gionfriddo, and CBC, Judge Kwan affirmed the “significant public interest in the Olympics and the athletes involved in the Olympics” 171 and thus fell within California’s statutory “public affairs” exemption as set forth in:

[T]he “use of a name, voice, signature, photograph, or likeness in connection with any news, public affairs, or sports broadcast or account, . . . shall not constitute a use for which consent is required under subdivision (a) . . . . ‘Public affairs’ is largely interpreted to “include things that would not necessarily be considered news” and “was intended to mean something less important than news.” 172

Finally, Judge Kwan stated that the plaintiffs did not “present admissible evidence showing that the Olympic Genome Project’s use of their names, images and biographical information impaired their economic interest. To the contrary, it is equally likely that Plaintiffs’ marketability was enhanced by the presentation of their names, images and biographical information on the Olympic Genome Project.” 173

In order to rule on the anti-SLAPP motion, the linchpin question before Judge Kwan was whether the speech conveyed in the Genome Project App constituted noncommercial speech (thus fall-

169 C.B.C. Distrib. & Mktg., Inc., 505 F.3d at 823.
170 Id. at 824.
ing within the scope of the anti-SLAPP statute), or instead should be classified as commercial (or a mix of both). Judge Kwan held that the speech at issue was noncommercial and thus fully protected speech under the First Amendment. In arriving at this decision, Judge Kwan heavily relied on Rezec v. Sony Pictures Entertainment, Inc. and the district court decision in Jordan I. In Rezec, the motion picture company depicted in its advertising campaign laudatory reviews that were attributed to a non-existent film critic that were alleged to be false. Although the Rezec court found that the film enjoyed complete First Amendment protection, the advertisement itself did not. In distinguishing Rezec, Judge Kwan stated that “the Olympic Genome Project does not contain false content, nor does it influence potential Facebook users to purchase specific Samsung products.”

Judge Kwan held that, unlike Rezec, the Genome Project was not a case that involved false advertising. Furthermore, the Genome Project did not contain advertisements specifically for particular Samsung products, did not have a click-through to Samsung’s main website, and did not offer gaming where Facebook users or consumers could earn discounts on Samsung’s product. The linchpin for Judge Kwan’s decision was the lack of any “call to action” to purchase specific Samsung products. Hence, while the deceitful movie reviews advertised in the Rezec case could have likely induced potential moviegoers to purchase tickets, there was nothing in the Genome Project that, as determined by Judge Kwan, could or would serve to induce users of the app to purchase Samsung products. Judge Kwan also relied heavily on the district court opinion in Jordan I. Before discussing Kwan’s rationale, an overview of the facts of Jordan I is warranted.

174 See id.
176 Jordan I, 851 F. Supp. 2d 1102 (N.D. Ill. 2012), rev’d, 743 F.3d 509 (7th Cir. 2014).
177 Rezec, 116 Cal. App. 4th at 137.
179 Id.
180 Id.
181 Id.
182 Id. at 2–3.
A. Jordan I Background

In 2009, Michael Jordan was inducted into the Basketball Hall of Fame. Sports Illustrated produced a special commemorative issue that exclusively featured Jordan’s career. The issue was not distributed to magazine subscribers, but was instead sold in stores. The defendant, operator of Chicago area grocery chain Jewel-Osco, was provided a free full-page ad in the magazine in exchange for selling the issue in its stores. The congratulatory ad was placed on the inside back cover of the magazine; it featured an image of a pair of sneakers featuring Jordan’s number “23,” and text that read:

A Shoe In! After six NBA championships, scores of rewritten record books and numerous buzzer beaters, Michael Jordan’s elevation in the Basketball Hall of Fame was never in doubt! Jewel-Osco salutes #23 on his many accomplishments as we honor a fellow Chicagoan who was “just around the corner” for so many years.

Under this text, the ad also featured Jewel-Osco’s registered trademark logo and its marketing slogan, “Good things are just around the corner.”

In response, Jordan sued Jewel-Osco alleging, inter alia, violations of the Illinois Right of Publicity Act. The district court be-

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184 Jordan I, 851 F. Supp. 2d 1102, 1104 (N.D. Ill. 2012), rev’d, 743 F.3d 509 (7th Cir. 2014).
185 Id.
186 Id.
187 Id.
188 765 ILL. COMP. STAT. ANN. 1075/5 (2016).

As used in this Act: “Commercial purpose” means the public use or holding out of an individual’s identity (i) on or in connection with the offering for sale or sale of a product, merchandise, goods, or services; (ii) for purposes of advertising or promoting products, merchandise, goods, or services; or (iii) for the purpose of fundraising. “Identity” means any attribute of an individual that serves to identify that individual to an ordinary,
gan its analysis by stating that “[a] significant and potentially dispositive issue”189 was whether Jewel-Osco’s advertisement was noncommercial speech, which would receive full First Amendment protection, or “commercial speech,” which would receive lesser protection.190 In siding for the defendant, the district court first noted that “the test for identifying commercial speech”191 turns on whether the speech proposed a commercial transaction.192 The district court stated:

It is difficult to see how Jewel’s page could be viewed, even with the benefit of multiple layers of green eyeshades, as proposing a commercial transaction. The text recounts some of Jordan’s accomplishments and congratulates him on his career and induction into the Hall of Fame. The shoes, the number 23, and the hardwood floor evoke Jordan and the sport and team for which he enjoyed his principal success. . . . At the most basic level, the page does not propose any kind of commercial

reasonable viewer or listener, including but not limited to (i) name, (ii) signature, (iii) photograph, (iv) image, (v) likeness, or (vi) voice.

Id.


189 Jordan I, 851 F. Supp. 2d at 1105.
192 Id. The court, in endeavoring to define commercial speech, also relied on Board of Trustees of State University of New York v. Fox, 492 U.S. 469 (1989), and Sorrell v. IMS Health, Inc., 131 S. Ct. 2653 (2011). See Fox, 492 U.S. at 482 (citing Sorrell, 131 S. Ct. at 2674 (referencing the “commonsense distinction between speech proposing a commercial transaction, which occurs in an area traditionally subject to government regulation, and other varieties of speech”)); Va. State Bd. of Pharm. v. Va. Citizens Consumers Council, Inc., 425 U.S. 748, 761 (“[S]peech that proposes a commercial transaction . . . is what defines commercial speech.”)).
transaction, as readers would be at a loss to explain what they have been invited to buy.\footnote{Jordan I, 851 F. Supp. 2d at 1106–07.}

Hence, the judge ruled that Jewel-Osco’s congratulatory advertisement was protected free speech, holding that the ad was a work in service of honoring and congratulating Jordan: a “tribute by an established Chicago business to Chicago’s most accomplished athlete.”\footnote{Id. at 1110–11.} The court further held that there was no profit motivation to commercially exploit the Jordan brand since Jewel-Osco was not compensated by TIME, Inc. for having created the ad.\footnote{See id. at 1111.}

\section*{B. Spitz Court’s Application of Jordan I}

Likewise, in Judge Kwan’s judgment, one could not argue that Samsung, despite the presence of its corporate logo and slogan, was engaged in anything more than a simple “proposal” of a commercial transaction because no specific Samsung products were advertised or promoted in the Genome Project.\footnote{See id.} Analogous to the rationale in \textit{Jordan I}, Samsung did not specifically encourage consumers to go to a consumer electronics store or to go online to purchase Samsung products.\footnote{Opposition to Motion to Strike, \textit{supra} note 149. The plaintiffs argued that the Genome Project App was clearly intended to drive sales of Samsung products and to enhance Samsung’s brand awareness with consumers. They further argued that Samsung used the athlete’s names and images without approval with the intent of creating the impression that Plaintiffs were endorsers of Samsung’s products and business.} Judge Kwan conceded, while citing to \textit{Jordan I}, that “even if the display of the Samsung logo could somehow be viewed as introducing minimal elements of commercialism, those elements are intertwined with and overwhelmed by the message’s non-commercial aspects, thereby rendering the entirety of the Olympic Genome Project non-commercial.”\footnote{Spitz v. Samsung Elecs. Am., Inc., No. BC 483475, 2013 WL 6816181, at *2 (Cal. Super. Ct. Jan. 10, 2013). Similarly, the district court in \textit{Jordan I} recognized that even if the presence of the store’s slogan in the advertisement (“Just Around the Corner”) could be arguably perceived as presenting some nominal commercial components, that element was intermingled with the message’s noncommercial elements, consequently transforming the entire advertisement into noncommercial speech. \textit{Jordan I}, 851 F. Supp. 2d at 1108.}
Judge Kwan thus held that users exploring Samsung’s Facebook app would be unlikely to believe that they were being invited to purchase any Samsung products. Further, she held that the fact that Samsung might have acted with economic motivation in generating the Genome Project did not, in and of itself, render the Facebook app commercial speech. Nor, she held, did Jewel-Osco’s economic motivation for generating and placing its page in the commemorative issue transform its congratulatory advertisement into commercial speech.

The plaintiffs argued that noncommercial “public interest” protected speech, when mixed with commercial speech, was not protected by the anti-SLAPP statute or by the Constitution. In addition, the athletes asserted that the app’s use of their name and image could not be protected since it improperly inserted public interest information with product and brand advertising. The plaintiffs relied in particular on *Downing v. Abercrombie & Fitch*.

In 1999, surfers George Downing, Paul Strauch, Rick Steere, Richard Buffalo Keaulana, and Ben Aipa sued Abercrombie & Fitch, alleging the apparel company had misappropriated their names and likenesses for commercial use. In this case, a picture featuring the plaintiffs engaged in a surfing competition held over thirty years prior was used by Abercrombie & Fitch in its catalog. The defendants argued, on the basis of the First Amendment, that the photographed illustrated an article about surfing, a matter of public interest. The court held, however, that “there is a tenuous relationship between [the] photograph and the theme presented. Abercrombie used [the] photograph essentially as window dressing to advance the catalog’s surf theme” and thus not protected by the First Amendment.
In opposition to the defendants’ argument that there was no direct connection between the alleged use of the Olympic athletes and the commercial purpose, the plaintiffs argued that the defendants had conceded an economic motivation for the app (specifically, to enhance Samsung’s brand image). Moreover, as the plaintiffs pointed out, citing Downing, “the Court never discussed whether there was a direct connection between the use of the picture and the defendant’s economic motivation, but implicitly found one, because it upheld the plaintiffs’ claim, even though the plaintiffs were never even identified in the catalog.” According to the plaintiffs’ claim, it was not an important issue whether or not there was direct connection between the use of the athletes’ picture and the commercial purpose in Downing. According to the Court’s decision in Downing, in addition, the use of the picture was held to not be protected as a matter of public interest and Abercrombie & Fitch could not be entitled to allege a First Amendment defense. For these reasons, the defendants in Spitz argued that Downing did not apply to the Genome Project because of the indirect connection between the use of the athletes and the defendants’ economic motivation.

The plaintiffs also relied on Kasky in arguing that Samsung’s Genome Project should be classified as commercial speech. However, Judge Kwan determined that the Kasky decision, like that in Downing, was in essence a false advertising case: “In contrast [to Nike] . . . the Olympic Genome Project does not make any representation of fact about Samsung’s products, does not promote specific Samsung products, and does not make any representations of fact about Samsung’s business, let alone representations alleged to be false.” Having thus determined that (1) Samsung’s Facebook app constituted public interest speech, (2) such speech was noncommercial in nature, and (3) the plaintiffs were unlikely to

209 Opposition to Motion to Strike, supra note 149, at 11.
210 Id.
211 Downing, 265 F.3d at 1002.
212 Opposition to Motion to Strike, supra note 149, at 11.
213 See supra notes 125–35 and accompanying text.
214 Opposition to Motion to Strike, supra note 149, at 11.
succeed on the merits of the case, Judge Kwan upheld the defendants’ anti-SLAPP motion.216

IV. JORDAN II: SEVENTH CIRCUIT FINDS “IMAGE ADVERTISING”

In February 2014, the Seventh Circuit overruled the lower court in holding that Jewel-Osco’s congratulatory advertisement amounted to commercial speech, and thus remanded the case back to the lower court to determine Jordan’s claims and damages.217 The Seventh Circuit began by acknowledging that the Supreme Court has generally “worked out” the commercial speech doctrine in public law cases,218 while noting that the Jordan case involved a “clash of private rights.”219

216 Id. at *3.
217 Jordan II, 743 F.3d 509, 512 (7th Cir. 2014). The Seventh Circuit acknowledged that the issue before it was simply whether the advertisement in question should be classified as commercial or noncommercial speech. The Seventh Circuit elaborated, however, that even if the ad is held to be noncommercial speech, “it is far from clear that Jordan’s trademark and right-of-publicity claims fail without further ado.” Id. at 514. Citing renowned trademark expert McCarthy, and the fact that the Supreme Court has yet to address this issue, the Seventh Circuit added that “there is a no judicial consensus on how to resolve conflicts between intellectual-property rights and free-speech rights; instead the courts have offered ‘a buffet of various legal approaches to [choose] from.’” Id. (citing 6 MCCARTHY, supra note 28, § 31.139).

As noted by the Seventh Circuit, in the public-law context, “the commercial/noncommercial classification determines the proper standard of scrutiny to apply to the law or regulation under review in the case.” Jordan II, 743 F.3d 509, 514 (7th Cir. 2014).
219 Jordan II, 743 F.3d at 514.
The Seventh Circuit’s decision turned on two issues: (1) how to define the scope of commercial speech and (2) how to handle advertising that contains elements of both commercial and non-commercial speech. Regarding the first issue, the court first acknowledged the accepted definition of commercial speech: “[S]peech that does no more than propose a commercial transaction ‘fall[s] within the core notion of commercial speech . . . .’”\(^{220}\) However, as the court continued, “other communications may also represent commercial speech despite the fact that they contain discussions of important public issues.”\(^{221}\)

The Seventh Circuit was specifically challenged with how to classify speech that contained both commercial and noncommercial elements, as was deemed to be the case here.\(^{222}\) The court first turned to *Bolger*,\(^{223}\) which provides three guideposts for classifying speech that contains both commercial and noncommercial elements, including “whether (1) the speech is an advertisement, (2) the speech refers to a specific product, and (3) the speaker has an economic motivation for the speech.”\(^{224}\) As the court elaborated: “This is just a general framework, however; no one factor is sufficient, and *Bolger* strongly implied that all are not necessary.”\(^{225}\) Still, the core of the court’s analysis focused on the second element

\(^{220}\) *Id.* at 516 (citing *Bolger*, 463 U.S. at 66).

\(^{221}\) *Id.* (citing *Fox*, 492 U.S. at 475). The Seventh Circuit added that the Supreme Court has “made clear that advertising which links a product to a current public debate is not thereby entitled to the constitutional protection afforded noncommercial speech.” *Id.* (citing *Zauderer v. Office of Disciplinary Counsel of the Sup. Ct. of Ohio*, 471 U.S. 626, 637 (1985)).

\(^{222}\) *Id.* at 517. The Seventh Circuit used *Jordan II* as an opportunity to clarify the proper use of the “inextricably intertwined” doctrine, which the district court had relied upon in holding for Jewel-Osco. *Id.* at 520. The court writes: “That doctrine holds that when commercial speech and noncommercial speech are inextricably intertwined, the speech is classified by reference to the whole; a higher degree of scrutiny may be applied if the relevant speech ‘taken as a whole’ is properly deemed noncommercial.” *Id.* (citing *Fox*, 492 U.S. at 474). The Seventh Circuit, in arguing that the court in *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180 (9th Cir. 2001), misapplied the doctrine, went on to suggest that it is difficult to identify a scenario in which both commercial and noncommercial speech could be “inextricably intertwined”: “No law of man or nature compelled Jewel to combine commercial and noncommercial messages as it did here.” *Id.* at 522.

\(^{223}\) *Bolger*, 463 U.S. 60 (1983).

\(^{224}\) *Jordan II*, 743 F.3d at 517.

\(^{225}\) *Id.*
of the *Bolger* test.226 Although Jewel-Osco argued that its advertisement did not propose a commercial transaction because it did not promote a specific product or service, the Seventh Circuit took an entirely different view:

The notion that an advertisement counts as “commercial” only if it makes an appeal to purchase a particular product makes no sense today, and we doubt that it ever did. An advertisement is no less “commercial” because it promotes brand awareness or loyalty rather than explicitly proposing a transaction in a specific product or service. Applying the “core” definition of commercial speech too rigidly ignores this reality. Very often the commercial message is general and implicit rather than specific and explicit.227

It was clear, the Seventh Circuit held, that the text of the advertisement was indeed “a congratulatory salute to Jordan.”228 However, the court focused on context of the advertisement, which included Jewel’s own graphic logo and slogan, by stating: “[I]f the literal import of the words [in the ad] were all that mattered, this celebratory tribute would be noncommercial. But evaluating the text requires consideration of the context . . . . Modern commercial advertising is enormously varied in form and style.”229 Hence, in adopting a broader interpretation of the term “commercial,” the court held that “an advertisement is no less ‘commercial’ because it promotes brand awareness or loyalty rather than explicitly proposing a transaction in a specific product or service.”230

The Seventh Circuit stressed that while the proposing of specific commercial transactions are at the “core” of commercial speech, such propositions do not demarcate the outer limits of

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226 *Id.* at 519.
227 *Id.* at 518.
228 *Id.* at 517–18. The court rejected Jewel-Osco’s argument that this advertisement was similar to others that Jewel-Osco had released in the past, which celebrated the work of local civic groups. *Id.* at 518.
229 *Id.* at 517–18.
230 *Id.* at 518.
what is commercial speech. Rather, even if speech does something more than (or in addition to) proposing a commercial transaction, it can still be commercial. As the court stated, Jewel-Osco’s advertisement served two functions: (1) congratulating Jordan, and (2) enhancing Jewel’s brand by associating itself with Jordan in the minds of basketball fans and Chicago consumers. Given that a “common-sense distinction” between commercial and noncommercial speech was proper, in this context, the court had to account for the varied, often subtle forms of modern advertising. Thus, an ad’s failure to refer to a specific product was held to be relevant, but not dispositive. The court had no trouble answering the question, “What does [the ad] invite the readers to buy?” The answer: “Whatever they need from a grocery store.” Hence, the Seventh Circuit ruled that this kind of brand advertising is not any less commercial than product advertising, since its “commercial nature is readily apparent” and it was “aimed at promoting goodwill for the Jewel-Osco brand by exploiting public affection for Jordan.” However sincere its congratulations, the court reasoned, Jewel-Osco still “had something to gain” from the ad.

The Seventh Circuit decision found particular significance in the characteristics and relevance of the logo and slogan as presented in the advertisement:

Jewel-Osco’s graphic logo and slogan appear just below the textual salute to Jordan. The bold red logo is prominently featured in the center of the ad and in a font size larger than any other on the page. Both the logo and the slogan are styled in their trademarked

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231 Id. at 516.
232 Id. at 518.
233 Id.
234 Id. at 517–18.
235 Id. at 518.
236 Id.
237 Id.
238 Id.
239 Id. at 520. The court also noted the fact that the trade deal between Jewel-Osco and Sports Illustrated, in which the former received a free full-page advertisement in exchange for selling the magazine in its stores, provided a clear economic benefit for Jewel-Osco. Id. at 519–20.
ways. Their style, size, and color set them off from the congratulatory text, drawing attention to Jewel-Osco’s sponsorship of the tribute.240

The Seventh Circuit stated that the linkage that Jewel-Osco created between their logo, slogan, and Jordan as “a fellow Chicagoan who was ‘just around the corner’ for so many years” was used to promote shopping at Jewel-Osco stores.241 The Seventh Circuit added that “[e]ven though the commercial nature of the ad may be generic and implicit, it is clear that it is a form of image advertising, which promotes goodwill for the Jewel-Osco brand “by exploiting public affection for Jordan at an auspicious moment in his career.”242 The court defined image advertising as a “form of advertising featuring appealing images and subtle messages alongside the advertiser’s brand name or logo with the aim of linking the advertiser to a particular person, value, or idea in order to build goodwill for the brand.”243 In other words, congratulating Jordan on his induction into the Hall of Fame seemed reasonable, but “considered in context, and without the rose-colored glasses, Jewel’s ad has an unmistakable commercial function: enhancing the Jewel-Osco brand in the minds of consumers. This commercial message is implicit but easily inferred, and is the dominant one.”244 The Seventh Circuit went on to expand the Bolger test noting that the Supreme Court foreshadowed that while the failure to refer to a specific product is a relevant consideration in the commercial-speech determination, it is far from dispositive, especially where “image” or brand advertising rather than product advertising is concerned.245

In remanding the case back to the district court, the Seventh Circuit took the opportunity to also clarify the district court’s misapplication of the “inextricably intertwined” doctrine.246 Jordan argued that the “inextricably intertwined” doctrine was not appli-
cable to this case. Specifically, Jordan argued that the district court had erroneously concluded that any advertisement that has a combination of both commercial and noncommercial speech should be deemed noncommercial speech because they are “inextricably intertwined” and cannot be separated out.

The Seventh Circuit, in concurring with Jordan I, held that the “central inquiry [was] not whether the speech in question combines commercial and noncommercial elements, but whether it was legally or practically impossible for the speaker to separate them.” It thus held that a single presentation that combines commercial and noncommercial elements does not automatically make the speech noncommercial. Furthermore, the Court concluded that the district court wrongly relied on a Ninth Circuit’s decision in Hoffman v. Capital Cities/ABC, Inc. that itself misapplied the “inextricably intertwined” doctrine. According to the Seventh Circuit, the commercial and noncommercial elements of the Jewel-Osco ad were not “inextricably intertwined”: “No law of man or nature compelled Jewel to combine commercial and noncommercial messages as it did here.” As a result, the district court should not have held that the commercial speech in the congratulatory advertisement was so intertwined with the noncommercial speech that they could not be separated. Jewel-Osco was not compelled by government regulation to incorporate the commercial speech in the advertisement and, thus, the “inextricably intertwined” doctrine was held not applicable.

247 Id. at 521.
248 Id.
249 Id. (citing Bd. of Trs. of State Univ. of N.Y. v. Fox, 492 U.S. 469 (1989)).
250 Id.
251 Hoffman v. Capital Cities/ABC, Inc., 255 F.3d 1180 (9th Cir. 2001).
252 Id. In Hoffman, actor Dustin Hoffman sued a magazine publisher for misappropriating his identity. Specifically, a fashion article featured movie stills that had been altered to make it appear as though the actors were modeling clothing from famous designers. Id. at 1183. Dustin Hoffman in his role in the film “Tootsie” was included in the article. The Ninth Circuit held that the article was fully protected noncommercial speech, because any commercial aspects are “inextricably intertwined” with expressive elements and, therefore, cannot be separated out. Id. at 1185.
253 Jordan II, 743 F.3d at 522.
254 See id.
255 Id.
As the court concluded:

A contrary holding would have sweeping and troublesome implications for athletes, actors, celebrities, and other trademark holders seeking to protect the use of their identities or marks. Classifying this kind of advertising as constitutionally immune non-commercial speech would permit advertisers to misappropriate the identity of athletes and other celebrities with impunity.256

As a result, the Seventh Circuit remanded the case for further proceedings, thus giving Jordan the green light to resume pursuit of his right of publicity claim in which he sought five million dollars in damages,257 and the parties eventually settled.258

V. DISCUSSION

The Spitz and Jordan cases have added yet another tile to the mosaic of competing rights. On one side of the scales of justice, we have the athlete’s right to control the form and manner in which his or her name, image and likeness (otherwise referred to a persona or identity) are used without authorization for the “purposes of trade.” On the other side, we have the First Amendment protections accorded by the right of free speech and expression. Adding further complexity to this balancing act is an ongoing quandary over how to define and distinguish non-commercial speech from commercial speech, particularly within the context of today’s modern image (or so-called brand) advertising. The increasing dominance of digital media as a platform for image advertising only portends, as suggested by Gervais and Holmes, escalating challenges.259 The Seventh Circuit decision in Jordan I, while creating some clarity and guidelines for future brand marketers, also leaves

256 Id. at 520.
257 Rovell, supra note 12.
258 See Seidel, supra note 16.
259 See Gervais & Holmes, supra note 80, at 183. Indeed, one can wonder the outcome if Jewel-Osco’s creative congratulatory message was communicated on its Twitter or Facebook account as opposed to in the pages of Sports Illustrated? Would the delivery vehicle, or ephemeralness, matter?
us with yet another wrinkle, particularly when viewed alongside the court’s holding in *Spitz.*

Courts and commentators continue to grapple with ways to articulate clear and generally applicable guidelines to resolve this conflict. Beyond the well-established triumvirate enunciated by the various courts for use in analyzing expressive mediums (the transformative use, relatedness (or Rogers) and predominant use tests), legal scholars have also proposed a plethora of novel approaches for balancing these important interests, the premise of which was appropriately suggested by one legal scholar: “[A] vague variety of tests must not be allowed to result in situations where public figures can turn their right of publicity into a right of censorship.” While not within the scope of this Article, it is worth noting a few of the prevailing themes, some of which naturally overlap: (1) a focus on the “primary motivation” of the plaintiff, including but not limited to the speaker’s economic motivations; (2) a fo-

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260 The authors readily acknowledge differences in the advertising campaigns: Samsung’s campaign utilizes the images of multiple athletes in connection with the publicly available statistical and biographical information, while the Jordan case involves the use of a single athlete in a congratulatory ad context. This, however, does not alter the fact that both campaigns were image advertising-based, and the decisions in both cases premised on a determination of what constitutes noncommercial versus commercial speech.

261 See Volokh, *supra* note 92, at 929–30 (“The right of publicity may seem intuitively appealing to many people. The notion that my name and likeness are my property seems to make sense. But, when applied to expression, ‘my property’ is another way of saying ‘legally forbidden to be another’s speech.’”); see also W. Mack Webner & Leigh Ann Linquist, *Transformation: The Bright Line Between Commercial Publicity Rights and the First Amendment,* 37 AKRON L. REV. 171, 179–80 (2004) (“As the Right of Publicity has become a more familiar cause of action, pleading of First Amendment defenses has increased and let to an unfortunate friction between these rights.”).

262 See Lee, *supra* note 71.


264 See Brandon, *supra* note 100 (discussing the Jordan district court decision and presciently predicting the Seventh Circuit rationale in overturning the same); see also Gloria Franke, *The Right of Publicity vs. The First Amendment: Will One Test Ever Capture the Starring Role?*, 79 S. CAL. REV. 945 (2006); Gil Peles, *The Right of Publicity Gone Wild,* 11 UCLA ENT. L. REV. 301 (2004) (proposing a test resembling copyright’s fair use doctrine that incorporates a transformative factor and the Second Circuit’s “newsworthy” test, as set forth in *Titan Sports v. Comics World Corp.*, 870 F.2d 85 (2d Cir. 1989), premised on the question of whether the economic value derives from the artistic expression or the celebrity). But see Redish & Shust, *supra* note 63, at 1481, 1488.
cus on the degree of bad faith intent, or malice, of the defendant;\textsuperscript{265} (3) a focus on the type of medium used;\textsuperscript{266} and (4) a focus on a rationale of consumer confusion premised upon the application of trademark law principles to such cases.\textsuperscript{267}

In \textit{Spitz}, the court held that a brand advertising campaign incorporating athletes’ names and likenesses is noncommercial speech because the campaign does not promote a specific product or service. The court in \textit{Spitz}, relying heavily on \textit{Jordan I}, ruled that the logo “Created by Samsung” was used simply to identify Samsung as the company responsible for the creation of the Olympic Genome Project.\textsuperscript{268} It held, further, that even if the logo introduced “minimal elements of commercialism, those elements are intertwined with and overwhelmed by the message’s non-commercial

\textsuperscript{265} See, e.g., Conrad, supra note 63, at 795–98. “[T]o avoid a chilling effect on the First Amendment, it is time to create a new sense of balance that limits one’s property rights to the situation in which they were intended: sole commercial purpose.” Id. at 809.


A court should ask, first, what is the “medium” at issue: is it plainly merchandise or a product, sold and marketed as such, such that its commercial value comes exclusively (or almost exclusively) from the celebrity’s name or likeness . . . . If so, there would be a presumption that the right of publicity would prevail over any First Amendment or free speech defense . . . . In order for the First Amendment to win out, the defendant would have to make a strong enough showing that his or her purpose was informative or expressive, not exploitative, to convince the court to overcome the presumption.

\textit{Id.} at 958.


aspects, thereby rendering the entirety of the Olympic Genome Project non-commercial.”

Hence, we see freedom of speech (the right to use information readily available in the public domain) trumping the right of publicity in the context of image advertising. In *Jordan II*, involving celebration of an athlete’s Hall of Fame achievement, the Seventh Circuit holds that an advertisement need not promote a *specific* product or service; instead, given the content-based particulars of the Jewel-Osco advertisement, it amounts to commercial speech due primarily to its classification as image advertising. In the context of the modern realities of consumer advertising, the Seventh Circuit set precedent in overturning the “inextricably intertwined” doctrine as relied upon in *Spitz* and *Jordan I*. Hence, we see the right of publicity trumping the freedom of Jewel-Osco to express itself with regard to Michael Jordan: “Congrats Michael!”

The Seventh Circuit, in assessing the facts in *Jordan II*, clearly embraced the opportunity to expand the *Bolger* test to better align with the realities of modern advertising (i.e., that a company’s image advertising serves as much a purpose of “selling” as does an advertisement for a specific product or service. Indeed, the decision appears precedent-setting). Hence, given the new import of image advertising, the Seventh Circuit decision arguably serves to...

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269 *Id.*

270 Based on the Seventh Circuit’s holding, Spitz would likely be wearing another victory medal!

271 What is not so clear is the outcome of this case had it involved a much less famous and revered celebrity than Michael Jordan. What is also not quite clear, and serves as the basis of a novel argument posited by Redish & Shust, *supra* note 63, is why corporate advertisers should not be treated the same as traditional media companies who utilize celebrity likenesses, since both have the same profit motivation. By way of example: BMW should be able to state in a print ad that Tom Cruise drives a BMW (assuming its truthfulness) in the same way that NBC News can report this in a story. It points to a double standard that begs the question: Why could Jewel-Osco not congratulate Jordan in an ad, but TIME, Inc., owners of *Sports Illustrated*, can use Jordan’s name and likeness to create an entire magazine, sell advertising in it, and then sell the magazine itself for substantial profit? Arguably, isn’t *Sports Illustrated*’s usage much more egregious? Jordan’s induction into the Hall of Fame was no more or less timely, or newsworthy, for *Sports Illustrated* than it was for Jewel-Osco.

272 A LexisNexis search for “image advertising” as commercial speech in athletes’ cases revealed no cases on point. It remains to be seen if similar doctrine will be adopted by other circuits (most notably, in light of the quick disposal of *Spitz* in California in the Ninth Circuit).
yet further expand (on the heels of the EA Sports rulings) the range of causes of action for athletes under the right of publicity doctrine. As a result, it becomes increasingly difficult to envision just how a company could express itself in congratulating a celebrity concerning a matter of public record without risking a right of publicity violation—a chilling notion. After all, only the least legally savvy of advertisers would combine a congratulatory message with a coupon. Given these factors, however, Jordan II does provide guidance on how this can be accomplished (at least with minimal legal risk) by establishing a continuum of sorts.

On one end of the continuum, the Seventh Circuit states that an advertisement that incorporates a brand logo and slogan is to be considered commercial in nature; the fact that it doesn’t identify or promote a specific product is irrelevant in today’s advertising world. On the other end, it applies a content-based analysis of Jewel-Osco’s advertisement that suggests that, absent some elements and creative executions, would place it within the realm of noncommercial speech. Although the Seventh Circuit’s content-specific analysis of the Jewel-Osco’s advertisement arguably creates many gray areas for future advertising copywriters and layout designers, one can also view the decision as providing a roadmap for how companies can utilize athlete personae in advertising (particularly congratulatory messaging) without violating the right of publicity. In fact, this roadmap was proposed to the court by Jordan’s legal team:

If Jewel and Supervalu merely wanted to congratulate Jordan as they claim, they easily could have done so. They could have privately congratulated Jordan. If they wanted to publicly congratulate Jordan, they could have done so without identifying themselves as speakers. And if they wanted to publicly congratulate Jordan and identify themselves as the speakers, they could have done so using their

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273 See supra notes 60–79 and accompanying text.
275 Jordan II, 743 F.3d 509, 519 (7th Cir. 2014) (“Dismissing the logo and slogan as ‘mere nametags’ overlooks their value as advertising tools.”).
corporate names (Jewel Food Stores, Inc. and Supervalu).\textsuperscript{276}

In other words, if Jewel-Osco had not prominently featured its brand logo and company slogan larger than its congratulatory messaging, had not cleverly married its slogan with Michael Jordan as (“Good things . . . just around the corner”), and had not espoused their shared geography (“fellow Chicagoans”), arguably Jordan could have been publicly congratulated within the parameters of the law. One can argue, alternatively, that the guidance for future congratulatory advertising boils down to this: creativity may kill.\textsuperscript{277}

CONCLUSION

The Seventh Circuit’s decision in \textit{Jordan II}, through both its novel application of the \textit{Bolger} test and analysis of mixed-messaged speech, arguably continues the expansion of publicity rights that comes on the heels of the EA Sports line of cases. Furthermore, \textit{Jordan II}’s embrace of “image advertising” as a proxy for advertising of specific products, in conjunction with the athletes’ right of publicity creates the potential chilling effect for companies and brands desiring to express themselves on matters of public interest and other newsworthy events involving athletes (including but not limited to recognition of career achievements and honors).\textsuperscript{278} As established by the Seventh Circuit, the consumer does not have to be invited to purchase a specific product in order for an advertisement to be deemed commercial speech. While it is not within the scope of this Article to reconcile \textit{Jordan II} with the numerous and varied approaches to balancing commercial speech with the right of publicity doctrine,\textsuperscript{279} the Seventh Circuit has provided several im-

\textsuperscript{276} Plaintiff-Appellant Michael Jordan’s Opening Brief and Required Short Appendix at 30, \textit{Jordan II}, 743 F.3d 509.

\textsuperscript{277} Indeed, one can argue, from the corporate marketer’s standpoint, that the fatal flaw in the Jewel-Osco’s congratulatory ad was simply the advertising copywriters’ desire to be clever and creative.

\textsuperscript{278} See Gervais & Holmes, supra note 80. “Indeed, the uncertainly associated with liability stemming from the right of publicity is potentially chilling speech.” \textit{Id.} at 211–12 (noting that EA Sports, in the face of legal challenges to the game’s use of college football players, ceased production of its popular NCAA Football videogame).

\textsuperscript{279} See supra Section I.F and Part II.
important guidelines for corporations and brands seeking to utilize athletes in advertising that would, at first glance, appear to be non-commercial in nature. First, the decision creates some degree of clarity in how closely and creatively an advertiser can align its brand messaging and indicia with the athlete. For corporations developing advertising and promotional literature, *Jordan II* further stresses the importance of reviewing advertisements for logos and other taglines, and in particular the size and location of such identifying marks in conjunction with the athlete identifiers. Jordan’s $8.9 million jury verdict against Dominick’s, coupled with his additional compensation deriving from the unreported settlement with Jewel-Osco,\(^{280}\) shows that even with a congratulatory message, judges and juries may not necessarily permit companies to get away unscathed for using a player’s image without permission, even if used in a non-traditional advertising context. The interplay between advertising and athletes’ rights of publicity has always required a delicate balance. For the time being, *Jordan II* has at least shined a brighter line on how corporations can navigate this world while limiting liability. In the meantime, legal scholars—and corporate advertisers—can only wait and hope that guidance from the Supreme Court in crafting a structured legal framework for reconciling publicity and commercial speech rights is “just around the corner.”

\(^{280}\) See Briscoe, *supra* note 16.